

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: ZVI Yaniv and Richard Fink

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Application No. 10/765,623

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on July 26, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

**EXAMINER'S ANSWER**

On April 20, 2006, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the Manual of Patent Examining Procedure (MPEP). Clarification is needed as to the rejection under 35 USC § 102(e) appearing on page 4 of the Answer. It should be noted that the same error appeared in the Final Rejection mailed September 22, 2005.

In the Examiner's Answer, the rejection reproduced below states:

“Claim 1 is rejected under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Nakamoto (U.S. 6,097,138).

In the paragraphs that follow this rejection of Claim 1, the Examiner's discusses the dependent claims 2, 3, 5 and 6, which were not rejected in the statement of rejection.

When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or their designee. *Manual of Patent Examining Procedure*, §1207.03(I). Further, a listing of any new grounds of rejection (prominently identified, eg., a separate heading with all capitalized letters) that has been approved by the TC Director or a designee. See *Manual of Patent Examining Procedure*, §1207.02(A)(6)(d). There is no indication on the record that the Technology Center Director or designee approved any new ground of rejection.

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed April 20, 2006 and mail a Supplemental Examiner's Answer with the approval of the Technology Center Director or designee.

### **APPEAL BRIEF**

The Appeal Brief filed February 2, 2006, is defective, because it does not comply with the required appendix headings as out line in the new rules established September 13, 2004.

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and

in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to final rejection.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each claim involved in the appeal, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Grounds of rejection to be reviewed on appeal. A concise statement of each ground of rejection presented for review.

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief

or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) Claims appendix. An appendix containing a copy of the claims involved in the appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If

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appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

A review of the application reveals that the following sections are missing from the Appeal Brief filed February 2, 2006:

(1) "Status of claims" as set forth in 37 CFR § 41.37(c)(1)(iii).

Appellant did not provide a statement of the status of the claims in the proceeding (e.g., withdrawn, objected to or canceled) and an identification of those claims that are being appealed.

(2) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);

Appellant did not provide a concise explanation of the subject matter defined in each of the independent claims involved in the appeal (Claims 1 and 7); and

(3) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c)(1)(vi);

The heading for this appendix is inappropriately labeled "ISSUES" and Appellant does not properly recite the rejection identified under 35 U.S.C. 102(e) or in the alternative 35 U.S.C. 103(a) (see page 4, Items 3, lines 14-16).

Appellant states:

"3. Claims 1-6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by, or, in the alternative, under 35 U.S.C. § 102(a) [sic, 103(a)] as being obvious over Nakamoto".

The Appeal Brief filed February 2, 2006, is defective. However, in view of the pending revised or Supplemental Examiner's Answer that the Examiner will issue (in due course), the above information is provided to Appellant for purposes of properly responding to the Examiner's Answer as required and/or in compliance with 37 CFR § 41.37(c).

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**CONCLUSION**

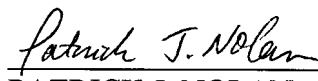
Accordingly, it is

**ORDERED** that the application is returned to the examiner to:

- 1) hold the Appeal Brief received February 2, 2006, defective;
- 2) hold the Examiner's Answer mailed April 20, 2006, defective;
- 3) issue and mail a revised Examiner's Answer, clarifying the rejection(s) and/or properly identifying any new ground of rejection (as outlined above);
- 4) approval of the the Technology Center Director or designee for any new ground of rejection is required;
- 5) for the Examiner's consideration of any Appeal Brief filed in response to the newly issued Examiner's Answer; and
- 6) for any such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e. abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

  
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PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571)272-9797

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